REMARKS

In the Office Action, the Examiner rejected claims 6, and 9-13 under 35 U.S.C. §101, as reciting non-statutory subject matter and rejected claim 6, and 9-13 under 35 U.S.C. §102(e) as being anticipated by Norris (WO 01/65441). Applicants respectfully traverse each and every rejection included in the Office Action.

By this amendment, Applicants have amended claims 6, 9, 10, and 13 of the application. Claims 6 and 9-13 remain pending. Applicants respectfully submit that the pending claims are in condition for allowance and request reconsideration and reexamination of this application.

AMENDMENTS TO THE CLAIMS

By this amendment, Applicant has amended claims 6, 9, 10, and 13. Exemplary support for the amendments to claims 6, 9, 10, and 13 may be found in the specification at page 25, line 11 - page 30, line 21 of the specification and in figures 4A and 4B.

THE CLAIMS RECITE PATENTABLE SUBJECT MATTER

Applicant respectfully traverses the rejection of claims 6 and 9-13 as being directed to non-statutory subject matter. The Examiner rejected independent claims 6, 9, and 13 as non-statutory, stating, "The claims have no associated physical transformation and therefore the claims are considered to recite only the § 101 judicial exceptions of mathematical abstraction and/or algorithm." Office Action, p. 2, ¶ 4.

As recognized, for example, in MPEP 2106,

> **If USPTO personnel can establish a prima facie case that a claim does not fall into a statutory category**, the patentability analysis does not end there. USPTO personnel must further continue with the statutory subject matter analysis as set forth below.
>
> (MPEP 2106 (empahsis added)

Because claims 6, 9, and 13 are directed to **systems**, as opposed to **processes** or **methods**, these claims fall squarely within four statutory categories of 35 U.S.C. §101 and no analysis of judicial exceptions, inherent in analyzing method claims, is necessary. Indeed, as amended, claims 6, 9, and 13 each recite computer processors, storage devices, and computer systems, illustrating that they recite a physical system. Moreover, the use of the claimed systems leads to a useful, tangible, and concrete result—the selection of a second main ingredient and a composition ingredient. This information, transferred to a prototype manufacturer computer system, allows for the manufacture of a prototype without disclosing confidential first main ingredient information to the prototype manufacturer.

Claims 10-12 recite a method of using a medicine prototype support system, including steps reciting a communications server and a database. The method leads to a useful, tangible, and concrete result—the selection of a second main ingredient and a composition ingredient. This claimed method, tied to a particular machine, also represents patentable subject matter under the MPEP.

CLAIMS 6, 9, AND 13 ARE ALLOWABLE OVER NORRIS

Applicants respectfully traverse the rejection of claims 6 and 9-13 as being anticipated by Norris.

Norris Does Not Select a Second Main Ingredient from a First Main Ingredient

As amended, claim 6 recites "information conversion means ... for selecting second main ingredient information that has one or more material properties similar to a confidential first main ingredient and from which it is difficult to estimate one or more medically effective ingredients of the confidential first main ingredient." Amended claim 9 recites "information conversion software that selects second main ingredient information having one or more properties similar to the confidential first main ingredient information and from which it is difficult to estimate one or more medically effective ingredients of the confidential first main ingredient information." Amended claim 13 requires information conversion for "selecting second main ingredient information by comparing properties of the confidential main ingredient information stored in the database with properties of a plurality of potential second main ingredients stored in the database." Norris does not teach or suggest at least these claimed features of the amended claims.

Norris neither teaches nor suggests the selection of second main ingredient information based on one or more properties of first main ingredient information. Instead, Norris allows a customer to provide performance criteria and to choose between suggested formulations. *See* Norris at 15, lines. 1-11; 7, lines 10-22. This presentation of formulations does not, however, suggest using one or more properties of confidential main ingredient information to select second main ingredient information.

Instead of choosing a non-confidential main ingredient to replace a confidential main ingredient, Norris provides the customer with all possible non-confidential formulations meeting that customer's performance criteria. *See* Norris at 15, lines. 1-11.

Amended claims 6, 9, and 13 further require that "it is difficult to estimate one or more medically effective ingredients of the confidential first main ingredient" from the selected second main ingredient. Norris does not teach this claimed relationship between the confidential first main ingredient and the second main ingredient, let alone the selection of the latter based on one or more properties of the former, as claims 6, 9, and 13 require.

Norris Teaches Only One Customer

Among other elements, claims 6, 9, and 13 require medicine prototype support systems that receive "a first request for prototype manufacture ... from the product manufacturer" and transmit "a second request for prototype manufacture ... to the composition manufacturer system." Norris fails to disclose or suggest at least this combination of features.

Norris describes a "system and method for the automated selection of formulations ... by specifying product characteristics ... ." *See* Norris at Abstract. The system taught by Norris "aggregates formulations ... from one or more suppliers" and allows **a customer** to "provide performance criteria to locate formulations that most appropriately meet their needs from a variety of suppliers." *Id.* at 7, lines 10-22. Figure 8 of Norris provides a "flow diagram of the process of a customer stepping through the Formulation Web Site to derive a set of formulations." *Id.* at 16, lines 1-2. Specifically, "**the customer** enters information that defines the formulation application, e.g. coatings,

glue, clock circuits, etc." and "enters limits and prioritizes features in selecting the formulation." *Id.* at 16, lines 3-5. A set of requirements is defined and used to generate a query. *Id.* at 16, lines 5-7. The results of this query are output, allowing **the customer** to "view the results," compare formulations, and "select desired ones of the formulations to save for later, purchase components, and etc." *Id.* at 16, lines 7-11.

Norris, therefore, teaches the presentation of formulations to **a customer** in response to "performance criteria" received from that same **customer**. Accordingly, Norris does not teach receiving "a request for prototype manufacture ... from the product manufacturer" and transmitting "a second request for prototype manufacture ... to the composition manufacturer system," as recited in claims 6, 9, and 13. Instead of receiving a first request for manufacture from a first manufacturer (the *product* manufacturer) and transmitting a second request for manufacture to a second manufacturer (the *composition* manufacturer), Norris receives a set of requirements from a first customer and transmits proposed formulations to that **same customer**.

Norris Does Not Select Composition Ingredients Based on Properties of the First and Second Main Ingredients

Claims 6 and 13 recite "composition ingredient determination means for selecting a composition ingredient based on the properties of the first and second main ingredients." Claim 9 requires "composition ingredient determination software that selects a composition ingredient based on the properties of the first and second main ingredients." Norris neither teaches nor suggests at least these elements of the pending claims.

The system taught by Norris "aggregates formulations ... from one or more suppliers" and allows a customer to "provide performance criteria to locate formulations

that most appropriately meet their needs from a variety of suppliers." *Id.* at 7, lines 10-22. Norris does not, however, describe selecting a composition ingredient for inclusion in a second request for manufacture based on "the properties of the first and second main ingredients." Instead, Norris teaches a system that allows the customer to select between several predetermined formulations, defined by the one or more suppliers.

CLAIMS 10-12 ARE ALLOWABLE OVER THE APPLIED REFERENCES

Applicants respectfully traverse the rejection of claims 10-12 as being anticipated by Norris.

As amended, independent claim 10 recites a method including the step of "using the database to select a second main ingredient having one or more properties similar to the confidential main ingredient and from which it is difficult to estimate one or more medically effective ingredients of the confidential first ingredient." As discussed above, Norris does not teach the selection of a second main ingredient based on the properties of a first main ingredient, let alone selecting a second main ingredient from which it is difficult to estimate medically effective ingredients of the confidential main ingredient.

As amended, independent claim 10 also recites a method including "receiving a first request for prototype manufacture from a product manufacturer," and "transmitting a second request for prototype manufacture to the composition manufacturer." Norris fails to teach or suggest at least this combination of features. As described above, Norris teaches the presentation of formulations to a customer in response to "performance criteria" received from that **same customer**. Thus, Norris does not teach receiving "a request for prototype manufacture ... from the product manufacturer" and

"transmitting a second request for prototype manufacture ... to the composition manufacturer system," as recited in claim 10.

Claim 10 further recites the step of "determining a composition ingredient based on the confidential main ingredient information and second main ingredient information," a step not taught by Norris. The system taught by Norris "aggregates formulations ... from one or more suppliers" and allows a customer to "provide performance criteria to locate formulations that most appropriately meet their needs from a variety of suppliers." *Id.* at 7, lines 10-22. Norris does not, however, describe selecting a composition ingredient for inclusion in a second request for manufacture based on "the properties of the first and second main ingredients."

For at least these reasons, claim 10 is allowable over Norris. Claims 11-12 are allowable at least due to their dependence from claim 10.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: April 28, 2009

By: _____
John M. Romary
Registration No. 26,331

1756338_3